REMARKS

I. Status of the Claims

Claims 1-3, 5-11, 18, 21, 24, 28, 32, 35, 40, and 41 are currently pending, with claims 35 and 40 withdrawn from consideration as directed to non-elected subject matter. Without prejudice or disclaimer, claims 1, 18, and 32 are amended herein, claims 12, 13, 19, and 34 cancelled, and claims 4, 14-17, 20, 22, 23, 25-27, 29-31, 33, and 36-39 were previously cancelled. Exemplary support for the amendments to claim 1 can be found in the as-filed specification, for example, at page 3, ¶ [014] and page 5, ¶ [024], and for claim 32, support is found in the as-filed specification, for example, at ¶ [065], bridging pages 15-16, and page 17, ¶ [068]. New claim 41 finds support in the as-filed specification, for example, at page 17, ¶ [068]. Claim 18 is amended to correct for dependency. Accordingly, no new matter is added and no issue of written description is raised by these amendments.

II. Statement Regarding Substance of Interview under 37 C.F.R. § 1.133(b)

Applicant thanks the Examiner for the time and courtesy extended in conducting a personal interview with Applicant's representatives on April 27, 2010 ("Interview"). During the Interview, a color version of the photographs included in the Declaration under 37 C.F.R. § 1.132 of Florence LAHOUSSE dated December 17, 2009, ("the LAHOUSSE Declaration") were presented to the Examiner. Applicant agrees with the Interview Summary dated May 6, 2010, in that no formal agreement was reached.

III. Rejection under 35 U.S.C. § 102(b)

The Office maintains the rejection of claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34 under 35 U.S.C. § 102(b) as allegedly "being anticipated by" U.S. Patent No.

3,911,105 ("the '105 patent") for the reasons of record. Final Office Action at 2. Applicant respectfully disagrees and traverses the rejection for the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992).

In the present case, the Office has failed to show that each and every element as set forth in the claims is expressly or inherently described in the '105 patent. Claim 1, as-amended, recites, in relevant part, that the "cosmetic composition itself has a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, and is heat-stable." In contrast, the '105 patent fails to disclose that the cosmetic compositions therein have any particular thermal profile, much less a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, and are heat-stable.

While the '105 patent fails to disclose all the claimed elements in a single embodiment, thus failing to pass the proper test under 102 (*see e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)), the Office implies that the omitted elements in the '105 patent are inherently disclosed.

For example, in the Final Office Action, the Office takes the position that because claim 5 of the '105 patent recites the elected species polystearyl acrylate, then

the corresponding composition inherently has the presently claimed thermal profile and is heat-stable. *See* Final Office Action at 3.

Applicant submits that the proper standard for inherent anticipation follows that "the prior art necessarily functions in accordance with, or includes, the claimed limitations," regardless of whether persons of ordinary skill in the art would "recognize the inherent characteristics or functioning of the prior art." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999) (citing *In re King*, 801 F.2d 1324, 1326, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). Therefore, in order to rely on such a theory of inherency, the Office must provide a basis in fact and/or technical reasoning to support the assertion that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *See* M.P.E.P. § 2112(IV). Here, the Office fails to provide sufficient factual and technical reasoning to establish that the inherent features (*e.g.*, heat-stable cosmetic compositions that have a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C) flows from the teachings of the '105 patent.

As indicated in Examples 12-30 of the '105 patent, various components are added to the cosmetic compositions in addition to the homopolymer required. All of these components have their own melting points which affect the overall thermal profile and heat stability of the cosmetic composition. For instance, Example 12 contains ozokerite (mp = 73°C - 76°C), lanolin (mp = 36°C - 42°C), cetyl ricinoleate (mp = 27°C), and polyvinylstearate (mp = 45°C)[1]. Therefore, Examples 12 of the '105 patent contains

[1] Applicant submits herewith technical descriptions for ozokerite, polyvinylstearate, cetyl ricinoleate and lanolin.

several components with significantly different melting points, which ultimately affect the overall thermal profile and heat stability of the cosmetic composition.

This is further demonstrated in the LAHOUSSE Declaration submitted in the previous Response dated December 17, 2009. Example 29 of the '105 patent (but using polystearyl acrylate instead of the homopolymer of Example 1) was evaluated for heat stability compared with a composition prepared according to the invention. The LAHOUSSE Declaration shows that a composition of Example 29, including polystearyl acrylate, does not possess the heat stability of a composition prepared in accordance with the pending claims.

Thus, the LAHOUSSE Declaration demonstrates that the heat stability recited in claim 1 are not inherent results of a composition simply comprising polystearyl acrylate. This is because it is not only the melting point range of the semi-crystalline polymer, but the melting points of all of the components in the composition that ultimately affect the heat stability of the cosmetic composition. Applicant respectfully submits that the compositional thermal profile and heat stability recited in the rejected claims therefore do not flow from the teachings of various components with significantly different melting point ranges, as described in the '105 patent, and as such, does not flow from the teachings in the '105 patent to inherently anticipate the claimed cosmetic compositions.

Accordingly, the rejection is improper, and Applicant respectfully requests its withdrawal.

IV. Rejection under 35 U.S.C. § 103(a)

The Office maintains the rejection of claims 1-3, 5-14, 18, 21, 24, 28, and 31-34 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" the combination of the

'105 patent and U.S. Patent No. 6,875,245 ("the '245 patent") for the reasons of record. Final Office Action at 5. Applicant respectfully disagrees and traverses the rejection for the following reasons.

Regarding support for a Section 103(a) rejection, the Supreme Court stated that "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). The Court outlined several approaches that may be appropriate for determining obviousness, the majority of which require that the teachings relied on to establish nonobviousness predictably lead to the claimed invention. *See* M.P.E.P. 2141(III).

Although the '245 patent is relied upon for its alleged disclosure of gum arabic, Applicant respectfully submits that the combination of the '105 patent and the '245 patent, as a whole, do not establish a *prima facie* case of obviousness. As discussed above, the '105 patent fails to guide one of ordinary skill in the art to formulate heat-stable cosmetic compositions having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C as presently claimed, and the '245 patent does not cure the deficiencies of the '105 patent.

The '245 patent fails to disclose any thermal profile for its resin composition, much less a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C as presently claimed. And, like the '105 patent, the '245 patent discloses that its compositions can contain a myriad of different components, each of which can have various melting point temperatures. For example, the '245 patent teaches that the following components may be added: waxes that have a melting point temperature ranging from 30 °C to 120 °C, fillers having "a melting point at least

greater than 150 °C, for example greater than 170 °C and further as for example, greater than 200 °C," pasty fatty substances "with a melting point ranging from 20 °C to 55 °C," film-forming silicone resins having "a melting point ranging from about 40 °C to about 80 °C," etc. *See* the '245 patent at col. 23, ll. 5-7, col. 31, ll. 57-59, col. 33, ll. 22-25, and col. 35, ll. 9-11. Essentially, the '245 patent teaches many components with significantly different melting points that may be added to its compositions with no indication as to which components to pick and choose in order to result in heat-stable compositions having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C.

For at least this reason, the '105 patent, even if combined with the '245 patent, does not disclose or suggest Applicant's claimed invention as recited in independent claim 1.

V. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant, therefore, respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 9, 2010

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Attachments:
(a) Material Safety Data Sheet for Ozokerite Wax
(b) Material Safety Data Sheet for Poly(vinyl stearate)
(c) Material Safety Data Sheet for Lanolin
(d) Technical Data Sheet for Cetyl Ricinoleate, from CasChem, Inc.